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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,108	09/08/2000	Kenneth S. Morley	11960.3112	3051

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EXAMINER

NGUYEN, PHUONGCHI T

ART UNIT	PAPER NUMBER
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2833

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,108

Applicant(s)

MORLEY ET AL.

Examiner

Phuongchi Nguyen

Art Unit

2833

MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 9-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other: \_\_\_\_

DETAILED ACTION

1. Acknowledgment is made of applicant's amendment of September 22, 2003. It is noted that claim 1 is amended.

*Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Margalit et al (US6554621B1).

In regard to claim 1, Margalit et al discloses an adaptor (Attachment 1) that enables re-orientation of a peripheral adaptor (A) comprising an Universal Serial Bus (USB) (column 2, last line) series "A" plug (A1) with (at least) four contacts (it is inherent); a peripheral interface (B) enabled to allow the attachment of the peripheral (adaptor A) in (two) different orientations, the peripheral interface (B) being fixably coupled and electrically connected to the USB plug (A1, one end of A) such that the contact (it is inherent) are electrically extended (because A and B are physically connected) to the peripheral interface (B) for access by the peripheral (adaptor A).

In regard to claim 4, Margalit et al discloses the peripheral interface (A) has an extraction force (fiction force/fixing force) in excess (larger than) of the extraction force (pulling force) associated with the plug (A1) so that the plug (A1) stays attached to the peripheral interface (A) when the plug (A1) is extracted from (any) receptacle.

*Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit et al (US6554621B1) in view of Crane (US4932902).

In regard to claim 2, Margalit et al lacks the adaptor has four by four matrix of contacts. However, Crane teaches a connector (figure 1) wherein the different orientations are one of four possible orientations and wherein the peripheral interface (22) further comprises a four by four matrix of contacts (20) arranged so that the peripheral interface (32) may use the same four contact connector configuration in all four of the possible orientations, thereby enabling the same peripheral connector to be used regardless of the desired orientation. It would have been obvious to one having ordinary skill at the time the invention was made to modify the peripheral interface of Margalit by providing a four by four matrix of contacts as taught by Crane for ease re-orientation the connector in four directions.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit et al (US6554621B1).

In regard to claims 5 and 6, it would have been obvious to one having ordinary skill at the time the invention was made to provide the amount of force on the peripheral interface of Margalit et al to be suitable larger enough with the force applied by the user.

7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit et al (US6554621B1) in view of Yen (US5880721).

In regard to claims 7-8, Maragalit et al lacks the peripheral being configureable as a wireless device. However, Yen teaches (figure 4) the peripheral (10) is configureable as a wireless device enabling short-range wireless communication (Column 1, line 1), further comprising an antenna (7, 9) oriented in an upward direction. It would have been obvious to one having ordinary skill at the time the invention was made to modify the peripheral interface of Maragalit et al by replacing wireless interface as taught by Yen for ease connecting, disconnecting the interface adaptor when the user is in traveling.

***Response to Arguments***

8. In regarding to election of species restriction, based on MPEP 35 U.S.C. 121, two or more distinct inventions may not be claimed in one invention; Specie I: Figures 1-3e with claims 1-2, 4-8 and Species II: Figures 4-6 with claims 11-13; and Applicant do not provide reasons to support that the peripheral interface 24 as shown in figure 2 has the same structure as the peripheral interface 25 as shown in figure 4.

The peripheral interface 24 comprises two coupling adapter interfaces 22 and 26; the interface 22 is coupling to the mating interface 12, another interface 26 is coupling to peripheral interface 28 of the transceiver module 30 (figure 2).

Contradicting to the peripheral interface 25, the peripheral interface 25 comprises two coupling adapter interfaces 22 and 26; the interface 22 is coupling to the mating interface 12, another interface 26 is coupling to the circular of the 90 degree rotational interface of the adaptor interface 44. The adaptor interface 44 comprises two coupling, one is the circular of 90-degree

rotational interface, and another is series B plug (contacts 45, 47, 49, 51), that is coupling to peripheral interface 46 of the transceiver module 30 (figure 4).

It is obvious that the peripheral interfaces 24 and 25 of figures 2 and 4 are two different inventions.

9. In response to applicant's argument of the rejection 103(a), that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

10. In response to applicant's argument of claim 4, "the extraction force" between the peripheral interface and the plug is caused by handling when two connector devices coupled or separated to each other. The "extraction force" is made by handling does not need to provide in the prior art because the force is made by the user.

11. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the amount of force on the peripheral interface of Margalit et al to be suitable larger enough with the force applied by the user.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchi T Nguyen whose telephone number is (703)305-0729. The examiner can normally be reached on Monday through Thursday from 8:00AM to 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (703) 308 - 2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7723 for regular communications and (703) 305-7723 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-3329.

December 15, 2003

  
P. AUSTIN BRADLEY  
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